

### **III. Remarks**

Claims 1-24 are pending, of which claims 13-21 were previously withdrawn for being directed to a non-elected invention. Claims 13-21 are canceled by the present paper. New claims 25-33 have been added. Applicants request reconsideration of claims 1-12 and 25-33 in light of the above amendments and the following remarks.

#### **Oath/Declaration**

The declaration was objected to because of inclusion of the word “the.” In particular, it has been requested that “material to the patentability” be changed to “material to patentability.” However, Applicants assert that the declaration as submitted satisfies the requirements of 37 CFR 1.63. Simply put, the inclusion or exclusion of the word “the” does not change the meaning of the statement set forth in the declaration. In that regard, 37 CFR 1.63 requires that “the person making the oath or declaration acknowledge[] the duty to disclose to the Office all information known to the person to be material to patentability as defined in §1.56.” However, even in 37 CFR 1.56 “material to patentability” and “material to the patentability” are used interchangeably. For example, 37 CFR 1.56(a) recites in part:

“Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by § 1.97(b)-(d) and 1.98.”  
(emphasis added)

Accordingly, Applicants assert that the use of “material to the patentability” satisfies the requirements of the 37 CFR 1.63. Therefore, Applicants request that the original declaration be accepted as filed.

### **§102 Rejections**

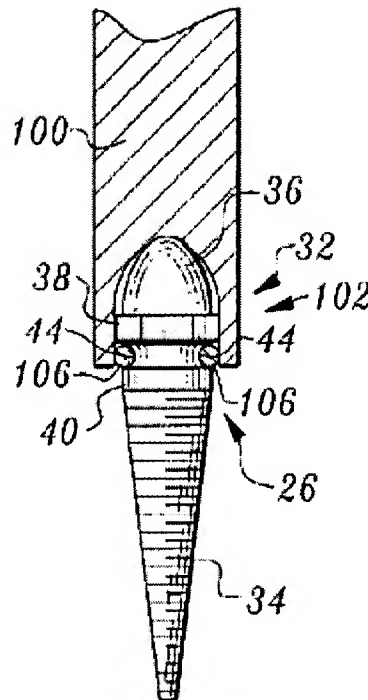
**Claims 1-12 and 22-24** stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2003/0055430 to Kim (“the Kim application”).

The PTO provides in MPEP §2131 that

“[t]o anticipate a claim, the reference must teach every element of the claim . . .”

Therefore, to sustain the rejection of claims 1-12 and 22-24 the Kim application must teach all of the claimed elements of each claim.

With respect to independent claim 1, the Kim application at least fails to disclose “a first anchoring fastener for movably coupling the first distracting arm to a first one of the vertebral bodies, wherein the first anchoring device is rotatable relative to the first distracting arm,” as recited. In that regard, there is no indication that the distractor pins 26 of the Kim application movably couple the armatures 50A, 50B to the vertebrae or that the distractor pins are rotatable relative to the armatures. Rather, the distractor pins 26 appear to rigidly couple the armatures 50A, 50B to the vertebrae. As shown in Fig. 9b, reproduced below, the head portion 32 of the distractor pin 26 fits tightly within the bore 104 of the armatures 50A, 50B. As shown, there is no space between section 38 of the distractor pin 26 and the inside wall of the armatures 50A, 50B when the head portion 32 is received within the bore 104.



*Fig. 9b*

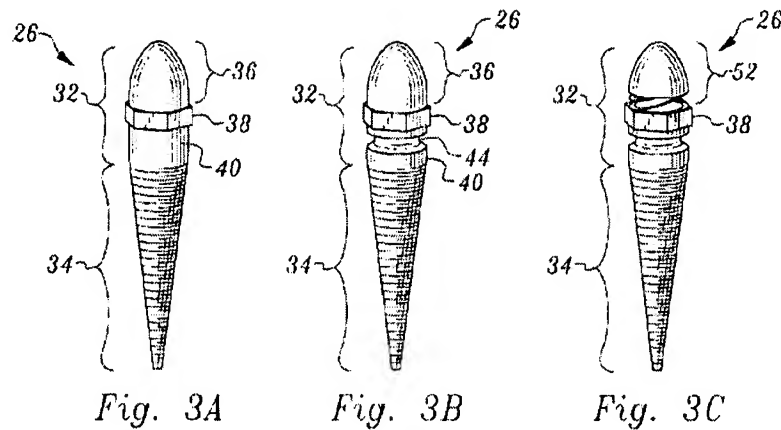
Further, “spring clamp 106 prevents distractor device 30 from migrating upward and slipping off of distractor pins 26.” Paragraph [0052]. As there is no space between section 38 of the head portion 32 and the inside wall of the bore 104 and the head portion is maintained within the bore by spring clamp 106, the distractor pins 26 appear to be substantially fixed relative to the armatures 50A, 50B. Accordingly, the distractor pins 26 do not movably couple either of the armatures 50A, 50B to a vertebra as required. Thus, for at least this reason the Kim application fails to disclose all of the recited elements of independent claim 1.

Claims 2-12 depend from and further limit claim 1. Therefore, for at least the same reasons the Kim application fails to disclose all of the recited elements of claims 2-12. Further, claims 2-12 recite additional limitations not disclosed by the Kim application. For example, claim 2 requires, “a second anchoring device for movably coupling the second distracting arm to a second one of the vertebral bodies.” As another example, claim 3 requires, “wherein the first and second distracting arms are movable in a parallel relationship, wherein the first anchoring fastener rotatably couples the first distracting arm to the first vertebral body, and further wherein the first vertebral body rotates relative to the first distracting arm as the first and second distracting arms move in a parallel relationship.” As another example, claim 9 recites, “wherein

the attachment of the shaping instrument to the instrumentation guide is adjustable as the first vertebral body rotates relative to the first distracting arm.” As another example, claim 11 recites, “wherein the first anchoring fastener comprises a partially spherical portion.” As a final example, claim 12 recites, “wherein the first distracting arm comprises an elongated slot, wherein the first anchoring fastener engages the elongated slot, and further wherein the spherical portion rotates in the elongated slot relative to the first distracting arm.” Thus, for at least these reasons the Kim application fails to disclose all of the recited elements of claims 2-12.

Accordingly, Applicants request that the §102 rejection of claims 1-12 over the Kim application be withdrawn.

With respect to independent claim 22, the Kim application at least fails to disclose, “a first anchoring fastener extending between the first distracting arm and the first vertebral body, wherein the first anchoring fastener comprises a first partially spherical portion and the first distracting arm comprises a first slot and further wherein the first partially spherical portion pivotally engages the first slot.” The Kim application also at least fails to disclose, “and a second anchoring fastener extending between the second distracting arm and the second vertebral body, wherein the second anchoring fastener comprises a second partially spherical portion and the second distracting arm comprises a second slot and further wherein the second partially spherical portion pivotally engages the second slot.” As noted above, the distractor pins 26 of the Kim application appear to be substantially fixed with respect to the armatures 50A, 50B. Accordingly, the distractor pins 26 do not pivotally engage a slot as required by claim 22. Further, the distractor pins 26 do not include a partially spherical portion. Rather, as shown in Figs. 3A, 3B, and 3C, reproduced below, the “head portion is tapered 36 at its top with an overall slender cylindrical profile below the tapered top having a substantially uniform cylindrical diameter.” Paragraph [0044]. Accordingly, the Kim application fails to disclose anchoring fasteners that have a partially spherical portion engaged with a slot of a distracting arm as recited.



For at least these reasons, the Kim application fails to disclose all of the recited elements of independent claim 22. Claims 23 and 24 depend from and further limit claim 22. Accordingly, Applicants request that the §102 rejection of claims 22-24 over the Kim application be withdrawn.

**New Claims 25-33**

New independent claim 25 recites limitations not disclosed by the Kim application. For example, claim 25 requires:

“a first anchoring element having a head portion and a bone engaging portion;

a second anchoring element having a head portion and a bone engaging portion;

a first distractor arm having a first opening, the head portion of the first anchoring element being received within the first opening;

a second distractor arm extending substantially parallel to the first distractor arm, the second distractor arm having a second opening, the head portion of the second anchoring element being received within the second opening;

wherein the first distractor arm is movable with respect to the second distractor arm for distracting the first and second vertebrae;

wherein the first distractor arm may pivot about the head portion of the first anchoring element when the bone engaging portion of the first anchoring element is securely engaged with the first vertebra; and

wherein the second distractor arm may pivot about the head portion of the second anchoring element received in the second opening when the bone engaging portion of the second anchoring element is securely engaged with the second vertebra.”

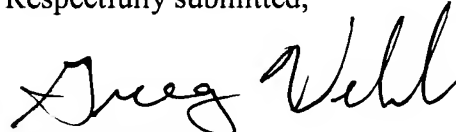
As this combination of elements is not disclosed by the Kim application and claims 26-33 depend from and further limit claim 25, Applicants assert that new claims 25-33 are patentable over the Kim application.

#### IV. Conclusion

Applicant believes that all matters set forth in the Office Action have been addressed and that all claims 1-12 and 22-33 are in condition for allowance. An early formal notice of allowance for claims 1-12 and 22-33 is requested.

Should the Examiner deem that an interview with Applicant's undersigned attorney would expedite prosecution, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

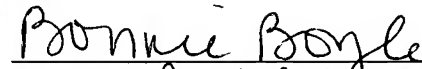


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~~Gayle Conner~~ Bonnie Boyle